REMARKS

Applicant has considered all points made by the Examiner in the Office Action and has responded to same in order to ensure compliance with the applicable rules.

1. Allowable Matter.

The examining attorney has determined that claims 3, 4, 7, 8, 13, 14, and 16 are allowable over the prior art of record.

The applicant thanks the examining attorney for the allowed claims.

2. 35 U.S.C. 112 rejection.

Claim 24 stands rejected under 35 U.S.C. §112 as being indefinite due to insufficient antecedent basis for "said associated image" and "said first record."

By amendment above, the applicant has removed any ambiguity with respect to claim 24. Therefore, Applicant respectfully requests that the Section 112 rejection be withdrawn.

3. 35 U.S.C. 102 rejections.

Claims 1, 5, 9-11, 17, and 19 stand rejected under 35 U.S.C. §102 as being anticipated by Mezei (U.S. Patent No. 6070175). Claim 12 stands rejected under 35 U.S.C. §102 as being anticipated by Warmus (U.S. Patent No. 6332149). Applicant respectfully traverses and submits that the claims 1, 5, 9-11, 17 and 19 are patentable over Mezei. Claim 12 has been canceled by amendment above.

Anticipation is a factual determination. In order to establish anticipation, it is incumbent upon the examining attorney to identify in a single prior art reference disclosure of **each and every element** of the claims in issue, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 U.S.P.Q. 481 (Fed. Cir. 1984); *In re Schaumann*, 572 F.2d 312, 197 U.S.P.Q. 5 (C.C.P.A. 1978) (anticipation is measured with respect to the terms of the claims in issue) (emphasis added). When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, or the inclusion of options not disclosed in the reference, the reference does not anticipate. *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1480, 1 U.S.P.Q.2d 1241, 1245-46 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909, 107 S.Ct. 2490 (1987).

"Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there." *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 43 U.S.P.Q.2d 1481, 1490 (Fed. Cir. 1997).

a.   Claims 1, 5, 9, 17 and 19.

Applicants' claims 1, 9, and 17 disclose adding a field directive to a record in a database wherein the field directive contains instructions to a pagination program. Claim 9 also discloses the addition of a second field directive to a second record in a database that will act as instructions to a pagination program. Applicants' claims 5 and 19 disclose a coding means for adding at least one field directive to provide instructions to a pagination program. The examining attorney cites Mezei at column 28, lines 21-36 and column 30, lines 13-22 as anticipating this element of these claims. The disclosure at column 28 is not oriented to, nor does it disclose, the creation or addition of directives or instructions to the pagination program. The cited text discloses the method of the ParagraphFormat function. (*see* col. 28, line 21). The ParagraphFormat function "allows a user ... to create a single table listing fifty-six paragraph format property names and values for the currently selected paragraph or specified format tag." (*see* col. 27, lines 61-64). In other words, the ParagraphFormat function allows the user to display currently existing attributes, not to set attributes.

Similarly, the disclosure in Mezei at column 30, lines 13-22 does not teach adding a field directive to a record. Rather, the cited text discloses the method of the ImportCGM function of Figure 57. The ImportCGM function allows a user to convert and import a CGM file into a format that can be edited at a later time as a FrameMaker document. (*see* col. 29, lines 1-3).

Claims 1 and 17 also disclose the addition of code to the record to make a file readable by the pagination program. The examining attorney cites Mezei at column 28, lines 55-65 and column 29, lines 30-51 as anticipating this element of these claims.

The disclosure at column 28, lines 55-65 provides an enumeration of programs provided according to the system which "allow exchange of files with other applications by adding the capability to compress or uncompress a document ..., encrypt or decrypt a document, ... and convert[] a CGM graphic into a graphic [editable] by FrameMaker...." The disclosure at column 29, lines 30-51 provide a step-by-step disclosure of converting a compressed, "zipped", or encrypted file

into a FrameMaker-compatible file. Neither of the cited sections provides for the addition of code to a record to make that record readable by a pagination program.

Because the adding of a field directive to a record in a database, and means thereof, are disclosed in Applicants' claims 1, 5, 9, 17, and 19 and the adding of code to a record are recited in Applicants' claims 1 and 17 but are absent from Mezei, the Mezei reference cannot anticipate those claims.

In light of the above, Applicant respectfully submits that claims 1, 5, 9, 17 and 19 are not anticipated by the Mezei reference. Accordingly, Applicant respectfully requests the examining attorney to withdraw the rejection under 35 U.S.C. § 102(b) for claims 1, 5, 9, 17 and 19.

b.   Claims 10 and 11.

Applicants' claims 10 and 11 disclose adding computer code to database records such that a resultant generated computer file will have a desired output, generating the computer file from the records, and analyzing the records to determine when all records have been obtained from the computer database. The examining attorney cites Mezei at column 6, lines 6-17 as anticipating the step of adding computer code to the database records. Although the disclosure at column 6 does discuss the use computer code in the form of "C" language programs, that code is not added to database records. Rather, that is the programming language in which the system disclosed by Mezei is written. Therefore, the adding of computer code to database records is not disclosed therein.

Because the adding of computer code to database records is disclosed in Applicants' claims 10 and 11 but is absent from Mezei, the Mezei reference cannot anticipate these claims. In light of the above, Applicant respectfully submits that claims 10 and 11 are not anticipated by the Mezei reference. Accordingly, Applicant respectfully requests the examining attorney to withdraw the rejection under 35 U.S.C. § 102(b) for claims 10 and 11.

4.   **35 U.S.C. 103 rejections.**

Claims 2, 6, 18, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mezei in view of Sutcliffe (U.S. Patent No. 6253216). Claims 21-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mezei in view of Zellweger (U.S. Patent No. 5630125). Applicant respectfully traverses these rejections.

a.   Mezei in view of Sutcliffe.

The combination of Mezei with Sutcliffe does not teach all of the claim limitations of Applicants' invention. "To establish a *prima facie* case of obviousness … the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. § 2143; *see In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As noted above, Mezei does not teach the adding of a field directive to a record in a database and the adding of code to a record as disclosed in Applicants' claim 1. These elements are also absent from Sutcliffe.

Also absent from the Mezei/Sutcliffe combination is determination if a recipient has an inherent characteristic which would preclude the delivery of the subject output. The examining attorney cites Sutcliffe at column 10, lines 32-37 and Step 166 of Figure 4 as providing this step. However, lines 32-37 of Sutcliffe discloses the tracking of statistical information (e.g., number times viewed, last viewed, etc.) regarding a personal web page. In addition, Step 166 of Sutcliffe permits a user of the system to manually determine if another user may access his personal page. There is no disclosure of automatically terminating the publication of a user's personal page based upon any characteristics.

Because the combination of Mezei and Sutcliffe does not teach all of the limitations of Applicants' invention, the combination does not establish a prima facie case of obviousness.

b.   Mezei in view of Zellweger.

i.   *Combination does not Teach All Claim Limitations*

The combination of Mezei with Zellweger does not teach all of the claim limitations of Applicants' invention. "To establish a *prima facie* case of obviousness … the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. § 2143; *see In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As noted above, Mezei does not teach the adding of a field directive to a record in a database and the adding of code to a record as disclosed in Applicants' claims 21 and 24. These elements are also absent from Zellweger.

Because the combination of Mezei and Zellweger does not teach all of the limitations of Applicants' invention, the combination does not establish a prima facie case of obviousness.

ii.   *No Motivation to Combine Mezei with Zellweger*

In order to make obvious Applicants' claimed invention, there must be some suggestion or motivation to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 U.S.PQ.2d 1438 (Fed. Cir. 1981). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Mezei discloses an information processing system oriented towards the creation of paginated documents. Zellweger discloses "a system for building a stand-alone information system that uses a hierarchical data structure, and that is optimized for use with mass storage devices and desktop computers." The examining attorney proposes that one skilled in the relevant art would have been motivated to combine Mezei with Zellweger.

The P.T.O. field search classification is evidence of analogy between two putative prior art references. M.P.E.P. 2141.01(a). Because none of the search field classifications of Mezei is shared by the search field classifications of Zellweger, Applicants respectfully submit that in the judgment of prior examining attorneys there is insufficient analogy between the two references to find a motivation to combine. In addition, the inventions claimed in the two references are directed towards different types of markets. Mezei is directed towards individuals and entities with a need to format documents for their purposes. Zellweger, however, is directed towards software application developers to assist in the creation of standalone computer applications. It is not likely that one skilled in the art would view these two divergent disclosures and find a motivation to combine the two.

Assuming but not admitting some motivation to combine Mezei with Zellweger, the subject matter of Zellweger is not "reasonably pertinent to the particular problem with which the inventor is involved," as is required for obviousness. *In re Clay*, 25 U.S.P.Q.2d 1059, 1060 (Fed. Cir. 1992). The creation of paginated documents for publication is not pertinent or analogous to the creation of stand-alone information systems designed to run on small computers.

Because there is no motivation to combine of Mezei with Sutcliffe, the combination cannot establish a prima facie case of obviousness.
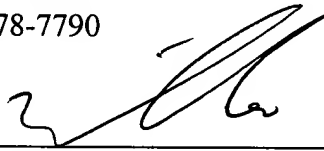
CONCLUSION

For the foregoing reasons, it is submitted that the proposed amendments comply with 37 CFR 1.116 and should therefore be entered, and with their entry that the application is now in condition for allowance. Such action therefore is respectfully requested.

Respectfully submitted,

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